

REMARKS

Reconsideration of the Final Office Action mailed March 14, 2005, (hereinafter "instant Office Action"), entry of the foregoing amendments and withdrawal of the rejection of claims 1-35, 37-40, 44, 45, 47 and 51-88, are respectfully requested.

In the Final Office Action, claims 1-35, 37-40, 44, 45, 47 and 51-88 are listed as pending, and claims 1-35, 37-40, 44, 45, 47 and 51-88 are listed as rejected.

The following claims have been amended to remove markings from prior amendments: claim 6 at pages 11 and 12, claim 7 at page 13, claim 8 at page 15, claim 10 at pages 17 and 18, claim 11 at page 19, claim 18 at page 29 and claim 32 at page 43.

The Examiner has maintained the rejection of claims 1-35, 37-40, 44, 45, 47 and 51-88 under 35 U.S.C. §112, second paragraph, for allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully traverse this rejection and maintain the arguments presented in the Replies filed December 23, 2004, May 17, 2004, March 15, 2004, July 28, 2003, and August 11, 2005. The Examiner acknowledges the definition pointed out by Applicants in the reply filed December 23, 2004 and states that "[a]pplicants should simply include this definition into the claims because C₁-C₆ is a well known prefix which appears before the terms alkyl, alkenyl, alkynyl which is here missing." As the Examiner has acknowledged, because C₁-C₆ is a well known prefix which appears before the terms alkyl, alkenyl, alkynyl and thus is it not necessary for Applicants to incorporate the definition from the specification into the claims.

M.P.E.P §2173.01 states:

A fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as any special meaning assigned to a term is clearly set forth in the specification.

In compliance with M.P.E.P. §2173.01 Applicants have set for the meaning of the term C₁-C₆ on page 54, lines 19-21, as pointed out to the Examiner in the Reply filed December 23, 2004.

M.P.E.P §2173.02 states:

The Examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph, is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available...If the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C. 112, second paragraph, would be appropriate. See *Morton Int'l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464, 1470, 28 USPQ2d 1190, 1195 (Fed. Cir. 1993). However, if the language used by applicant satisfies the statutory requirements of 35 U.S.C. 112, second paragraph, but the examiner merely wants the applicant to improve the clarity or precision of the language used, the claim must not be rejected under 35 U.S.C. 112, second paragraph, rather the examiner should suggest improved language to the application (emphasis in original).

As discussed above, the Examiner acknowledges that C₁-C₆ is a well known prefix which appears before the terms alkyl, alkenyl, alkynyl. The metes and bound of the claim can be interpreted by one of ordinary skill in the art as required by 35 U.S.C. §112, second paragraph. Applicants have satisfied the statutory requirements of 35 U.S.C. §112, second paragraph. Claims 1-35, 37-40, 44, 45, 47 and 55-88 should not be rejected under §35 U.S.C. §112, second paragraph, merely because the Examiner desires different language.

M.P.E.P. §2173.05(b) states:

If the claims, read in light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the statute (35 U.S.C. 112, second paragraph) demands no more. *Shatterproof Glass corp. v. Libbey Owens Ford Co.*, 758 F.2d 613, 225 USPQ 634 (Fed. Cir. 1985)

Applicants have provided a definition of the term "C₁-C₆" in the specification, the Examiner has acknowledged that "C₁-C₆" is a well known term, and in the Reply filed August 14, 2005, Applicants provided a copy of granted U.S. Patent U.S. Patent 6,660,744, issued December 9, 2003 wherein the claims recite the term "C₁-C₆". Applicants have met the burden of definiteness as defined by 35 U.S.C. §112, second paragraph, with respect to the term "C₁-C₆".

Based upon the foregoing, the rejection of claims 1-35, 37-40, 44, 45, 47 and 55-88 under 35 U.S.C. §112, second paragraph, for allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, is obviated and should be withdrawn.

The Examiner has maintained the rejection of claims 33-35, 37-40, 44, 47 and 51 under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention. Without conceding to the correctness of the Examiner's rejections and for the sole purpose of expediting prosecution of the instant application and to place it in condition for allowance, Applicants have cancelled claims 33-35, 37-40, 44, 47 and 51 without waiver or prejudice to Applicants' right to pursue the cancelled subject matter in a continuation or divisional application.

Based upon the foregoing, the rejection of claims 33-35, 37-40, 44, 47 and 51 under 35 U.S.C. §112, first paragraph, is obviated and should be withdrawn.

The Examiner has maintained the rejection of claims 1-40 and 44-88 under 35 U.S.C. §103(a) as allegedly being unpatentable over Altmann et al. (WO 97/49706). Applicants respectfully traverse this rejection. Applicants maintain the arguments presented in the Replies filed August 26, 2002, November 26, 2002, July 26, 2003, March 15, 2004, May 17, 2004, December 23, 2004 and August 11, 2005.

The Examiner alleges that "the reference teaches a generic group of substituted 7-amino-pyrrolo[3,2-d]pyrimidine derivatives which embraces applicants' claimed compounds". The Examiner points to Example 72 on page 35 as the closest prior art because it contains a 4-Ph-OH substituent over the 4-Ph-OPh group of the instant compound at R₁.

The Examiner alleges that the reference teaches 4-amino-7H-pyrrolo[2,3-d]pyrimidin-5-yl compounds having an optionally substituted phenyl as the 5-substituent which is further attached to -A-R₅ wherein A is -NH-SO₂- and R₅ is optionally substituted phenyl, etc. The Examiner further states that the instant claim differs by reciting specific species that fall within the reference genus. It is well established that a prior art genus does not make a basis for a *prima facie* case of obviousness for a later

genus because the species falls into the prior art genus. In re Baird, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994) ("The fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious"); In re Jones, 958 F2d 347, 350, 21 USPQ2d 1941, 1943 (Fed. Cir. 1992).

The Examiner has not established by clear and convincing evidence that one of ordinary skill in the art would have been motivated to select example 72 out of the 107 compounds disclosed in Altmann et al. as a lead compound. Yamanouchi, 231 F.3d at 344; see also Dillon, 919 F.2d at 602 (finding that *prima facie* obviousness is established "where the prior art gives reason or motivation to make the claimed compositions"). In In re Baird, *supra*, the court found:

...the generic diphenol formula disclosed in Knapp contains a large number of variables, and we estimate that it encompasses more than 100 million different diphenols, only one of which is bisphenol A. While the Knapp formula unquestionably encompasses bisphenol A when specific variables are chosen, there is nothing in the disclosure of Knapp suggesting that one should select such variables.

In much the same way, the genus of Altmann encompasses thousand of compounds and like In re Baird, when specific variables are chosen the genus of Altmann overlaps with Applicants' genus. In re Baird further found:

The diphenols that Knapp specifically discloses to be 'typical,' 'preferred,' and 'optimum' are different from and more complex than bisphenol A, we conclude that Knapp does not teach or fairly suggest the selection of bisphenol A. See In re Bell, 991 F.2d 781, 26 U.S.P.Q.2d (BNA) 1529 (Fed. Cir. 1993).

Like Knapp, Altmann discloses preferred examples and on page 8 states "[t]he invention relates especially to the specific compounds described in the Examples and to salts hereof." The majority of the examples in Altmann contain a phenyl substituted at the 5-position with a simple moiety such as methoxy. The examples in Altmann teach away from Applicants' genus. By teaching away from Applicants' genus Altmann cannot suggest Applicants' genus. Applicants have disclosed a genus which is different from and more complex than that of Altmann.

As in In re Baird, the reference discloses a genus with a number of variables which encompass a large number of possible compounds. Again, like In re Baird, the

reference does not provide any suggestion or motivation to arrive at exactly Applicants' genus. In re Deuel, 51 F.3d 1552, states:

...the question becomes whether the prior art would have suggested making the specific molecular modifications necessary to achieve the claimed invention. See In re Jones, 958 F.2d 347, 351, 21 USPQ2d 1941, 1944 (Fed Cir 1992), In re Dillon, 919 F.2d 688, 692, 16 USPQ2d 1897, 1901 (Fed. Cir 1990)(en banc) ("structural similarity between claimed and prior art subject matter,...where the prior art gives reason or motivation to make the claimed compositions, creates a *prima facie* case of obviousness")...In re Grabiak, 769 F.2d 720, 731-32 226 USPQ (Fed. Cir. 1985) ("In the case before us there must be adequate support in the prior art for the [prior art] ester/[claimed] thioester change in structure, in order to complete the PTO's *prima facie* case and shift the burden of going forward to the applicant." In re Lalu, 747 F.2d 703, 705, 223 USQ 1257, 1258 (Fed. Cir. 1984) ("The prior art must provide one of ordinary skill in the art the motivation to make the proposed molecular modifications needed to arrive at the claimed compound.").

One of ordinary skill in the art could select any number of variables and arrive at a genus different from Applicants' genus but which would also overlap with Altmann. The Examiner is using hindsight instead of pointing to the motivation that one would select precisely the right variables to arrive exactly at Applicants' genus based upon Altmann's disclosure. Merely because the genuses overlap does not make Applicants' genus obvious over Altmann. The chemical art is replete with patentable, overlapping genuses. The Examiner has not pointed out where and how Altmann suggests making the specific molecular modifications necessary to arrive exactly at Applicants' genus. Examiner has not made *prima facie* case of obviousness.

As discussed above in reply to the rejection of claims 33-35, 37-40, 44, 47 and 51 under 35 U.S.C. §112, first paragraph, Applicants have cancelled claims 33-35, 37-40, 44, 47 and 51. Based upon the foregoing, the rejection of claims 1-32 and 52-88 under 35 U.S.C. §103(a) over Altmann et al. (WO 97/49706) is obviated and should be withdrawn.

Based upon the foregoing, Applicants believe that claims 1-32 and 52-88 are in condition for allowance. Prompt and favorable action is earnestly solicited.

If the Examiner believes that a telephone conference would advance the condition of the instant application for allowance, Applicants invite the Examiner to call Applicants' agent at the number noted below.

Respectfully submitted,

Date: October 6, 2005

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